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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,856	10/12/2005	Ronald W. McGhee	16-946	2510
26294 7590 10/14/2009 TAROLLI, SUNDHEIM, COVELL & TUMMINO L.L.P. 1300 EAST NINTH STREET, SUITE 1700 CLEVELAND, OH 44114				
EXAMINER				
SELF, SHELLEY M				
ART UNIT		PAPER NUMBER		
3725				
MAIL DATE		DELIVERY MODE		
10/14/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/552,856

**Applicant(s)**

MCGHEE ET AL.

**Examiner**

Shelley Self

**Art Unit**

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 21-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

The amendment filed on July 20, 2009 has been considered but is ineffective to overcome the prior art reference and an action on the merits follows.

Examiner notes Applicant's response states, "Applicant's are filing herewith a timely terminal disclaimer..." however no terminal disclaimer has been received.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-15 and claims 21-25 as noted in the previous Office Action (4/23/09) are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 10/552873. Although the

conflicting claims are not identical, they are not patentably distinct from each other because there are merely reworded and encompass similar subject matter/scope.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-15 as noted in the previous Office Action (4/23/09) and claims 21-25 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 7,490,641. Although the conflicting claims are not identical, they are not patentably distinct from each other because as noted above regarding co-pending Application 10/552873, the claims of the presently presented application are merely reworded and broader than that of the patented case, '641. Accordingly the narrower claims of the patent '641 serve to anticipate the broadly presented claims of the current application.

### ***Specification***

The amendment filed July 20, 2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: *processing machine* (clms. 1, 24)

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-15 and 21-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Neither the originally filed disclosure nor the drawings provide support for a processing machine (clms 1, 24).

Claims 1-15 and 21-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. With regard to claims 1 and 24, neither the originally filed disclosure nor the drawings provide support for a processing machine. Examiner notes a processing machine in the woodworking art, maybe a planer, jointer, router/drilling combination machine, planer-sander combination machine and various other machines. The original disclosure supports structure including a planer, planer-matcher, or moulder. The recitation of a processing machine encompasses structure and embodiments not fully supported in either the original written disclosure or the drawings. Applicant is required to cancel the new matter in the reply to this Office Action.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15 and 21-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to claim 1, line 2 the recitation, "such as" renders the claim indefinite. Examiner notes line 4 references an optimizing planer, while lines 6, 9 and 10 reference a processing machine. Is the processing machine the same as the optimizing planer? Or are these elements different, if they are different how do the two elements interrelate and mechanically cooperate. What are the movable cutting elements and movable guiding elements operatively coupled to? Further regarding claim 1, the term "their" renders the claim indefinite. Examiner suggests clear and positively recitation of the structure to which "their" refers. Also how are the "respective optimized positions" determined, i.e. there is no recitation to any optimization occurring, calculated or determined therefore it is unclear how "their respective optimized positions" are determined. Is the infeed system operatively coupled to the planer or the processing machine? It is unclear whether a combination planer and infeed system or a combination processing machine and infeed system or merely an infeed system is being claimed. Accordingly the scope of the coverage sought can not be clearly ascertained and thus clarification is required.

With regard to claim 2, the term "their" renders the claim indefinite as noted in the previous Office Action.

With regard to claims 3-9 the claims reference "a workpiece" does this refer to the successive workpieces or array of workpieces of claim 1 or is this merely one workpiece of the successive or array of workpieces? Clarification is required.

With regard to claim 4, the planer has not been positively recited, therefore it is not clear whether or not the planer is part of the claimed invention.

With regard to claim 5, the claims states, "an optimizing planer" is this the same optimizing planer of claim 1 or an additional planer?

With regard to claims 11 and 13, neither the planer, nor any optimizing planing solution or cutting elements have been positively recited. How do these elements mechanically cooperate and interrelate with the rest of the positively recited limitations? Clarification is required.

With regard to claims 15 and 22, as noted above regarding claims 11 and 13, the planer has not been positively recited.

With regard to claim 22, the recitation, "and/or" renders the claim indefinite.

With regard to claim 24 the claim lacks critical mechanical cooperation between the elements, i.e. what are the sensors operatively coupled to?

With regard to claim 25, what are the movable cutting elements and movable guiding elements operatively coupled to? There is no antecedent basis for the recitation, "the optimizing planer" how does the optimizing planer interrelate with the rest of the positively recited limitations? Additionally regarding claim 25, the term their renders the claim indefinite as noted above with reference to claims 1 and 2.

Applicant's attempt to draft a broad claim encompasses confusing structure, and lack of clear recitation to critical structure. As noted in the previous Office Action, the claims lack clear

structure, the scope of the claims can not be ascertained and a clear understanding of the claimed invention is highly difficult. The claims appear to include method or processing steps as opposed to a proper apparatus claim. Examiner notes the above listing of 35 U.S.C. 112 rejections is not conclusive. Applicant is required to review ALL of the claims for clarity, definiteness and proper recitation of critical mechanical structure so as to facilitate a clear understanding of the claimed invention and proper application of the prior art.

### *Response to Arguments*

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Self whose telephone number is 571-272-4524. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached on 571-272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Shelley Self/  
Primary Examiner, Art Unit 3725

SS  
October 12, 2009